

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Peter M. Perthou
Serial No. : 09/752,015
Filed : December 29, 2000
Title : KEY RING

Art Unit : 3627
Examiner : Suzanne Dino Barrett
Conf. No. : 1179

Mail Stop Appeal Brief - Patents

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

THIRD APPEAL BRIEF

(i) *Real party in interest.*

Peter M. Perthou.

(ii) *Related appeals and interferences.*

A first Notice of Appeal was filed on January 23, 2003, the first Appeal Brief was mailed on April 28, 2003, the second Notice of Appeal was filed on January 6, 2006, the second Appeal Brief was filed on March 9, 2006, and Appeal No. 2007-2838, was decided on May 7, 2008 .

(iii) *Status of claims.*

Claims 3 and 5 being appealed stand rejected as unpatentable over the claim of U.S. Design Patent No. D435,720. Claims 1, 6 and 11 being appealed stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chen as a primary reference in view of Jung as a secondary reference and Momemmers as a tertiary reference. Claims 2 and 4 being appealed stand rejected under 35 U.S.C. §103(a) as being unpatentable over the primary, secondary and tertiary references and further in view of Miller as a quaternary reference.

(iv) *Status of Amendments.*

No amendment was filed subsequent to the third final rejection.

(v) *Summary of Claimed Subject Matter.*

Regarding claim 1, a key ring comprising a key-holding ring, such as 12, a band, such as web 13, a D-ring, such as 11, coupling said band to said key-holding ring, page 1, lines 16-18, page 2, lines 13-14, said D-ring having a U-shaped portion, such as legs 11A, 11B and bight 11C

engaging the key-holding ring and a bar, such as 11D, between the ends of the U-shaped portion and engaging the band. Page 2, lines 21-22.

Regarding claim 11, a method of making a key ring that includes a key-holding ring, such as 12, that is a spiral ring of material, page 2, lines 16-17, having a cross-sectional span, a band, such as web 13, a D-ring, such as 11, coupling said band to said key-holding ring and having a U-shaped portion, such as legs 11A, 11B and bight 11C, engaging the key-holding ring and a bar such as 11D, having bar ends between the ends of the U-shaped portion formed with a gap, such as 11E, intermediate said bar ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly, comprising, passing the key-holding ring through the gap into the D-ring, and passing the band through the D-ring. Page 3, lines 18-21.

(vi) *Grounds of Rejection to be Reviewed on Appeal.*

1. Whether claims 3 and 5 are unpatentable over the claim of U.S. Design Patent No. D 435,720 under the judicially created doctrine of obviousness-type double patenting.

2. Whether claims 1, 6 and 11 are unpatentable under 35 U.S.C. §103(a) over Chen as a primary reference in view of Jung as a secondary reference and Momemers as a tertiary reference.

3. Whether claims 2 and 4 are unpatentable under Sections 35 U.S.C. §103(a) over Chen as a primary reference in view of Jung and a secondary reference and Momemers as a tertiary reference and Miller as a quaternary reference.

(vii) *Argument.*

I. WHETHER CLAIMS 3 AND 5 ARE UNPATENTABLE OVER THE CLAIM OF U.S. DESIGN PATENT NO. D435,720 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING.

The final action states:

2. Claims 3,5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Design Patent No. D435,720.

An "obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that 'the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa'". *In re Dembiczak*, 175 F.3d 994, 1002 (Fed. Cir. 1999), quoting *Carmen Indus., Inc. v. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983). "In order for a design to be unpatentable because of obviousness, there must first be a basic design reference in the prior art, the design characteristics of which are 'basically the same as the claimed design'". *Dembiczak* at 1002, quoting *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996). Thus, for a utility patent application claim to render obvious a design patent claim, the utility patent application claim must indicate design characteristics that are basically the same as the claimed design. *See Dembiczak* at 1002.

The Appellant's claim 1, which is the sole independent claim among claims 1, 2, 4 and 6-10, recites "a key-holding ring". In view of that recitation, one of ordinary skill in the art would have envisaged the most basic of key-holding rings, i.e., the simple spiral round wire key-holding ring shown in Perthou's figures that has been ubiquitous for generations.

The Appellants claim 1 recites "a band". In view of that recitation, one of ordinary skill in the art would have envisaged the simplest of bands, i.e., the simple, plain, rectangular band shown in Perthou's figures.

The Appellant's claim 1 recites "a D-ring coupling said band to said key holding ring, said D-ring having a U-shaped portion engaging the key-holding ring and a bar between the ends of the U-shaped portion and engaging the band". That description describes the D-ring in Perthou's figures. In view of that recitation, the engagement between the D-ring and the key-holding ring that would have been envisaged by one of ordinary skill in the art would have been the conventional engagement, i.e., each ring passing through the opening in the other ring as shown in Perthou's figures. In view of that recitation, one of ordinary skill in the art would have envisaged the simplest engagement between the bar and the band, i.e., the band looped around a bar of the same width as the band as shown in Perthou's figures.

Moreover, during patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the Specification, as the claim language would have been read by one of ordinary skill in the art in view of the Specification, *see In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). Therefore, the Appellant's terms "key-holding ring", "band" and "D-ring" would have been construed by one of ordinary skill in the art as including those in the Appellant's figures 1-5, which are the same as those required by Perthou's claim.

Perthou's claim, however, as shown in the figures, requires what appears to be a clamp at the end of the band opposite the D-ring. The Appellant's Specification indicates that what appears to be a clamp in Perthou's figures is a clamp (Spec. 3:5-9), but the clamp is not recited in claim 1, its dependent claims 2, 4, 6, 7 and 9, or independent method claim 11. Thus, the Examiner has not established that the recitations in those claims are sufficient to have rendered Perthou's design patent claim *prima facie* obvious to one of ordinary skill in the art.

Also, the Appellant's claims 6-11 require a gap in the D-ring's bar. That gap is not shown in Perthou's figures. The Examiner has not explained, and it is not apparent, how Perthou's claim which lacks the appearance of a gap would have rendered the gap required by the Appellant's claims 6-11 *prima facie* obvious to one of one of ordinary skill in the art.

Claims 3 and 5

Claim 2, from which claim 3 depends, recites that the band is a web of material having ends looped through the D-ring and joined at the ends. That recitation describes the band and looping engagement between the band and the Dring shown in Perthou's figures. Claim 3 recites that there is a clamp at the ends of the web. In view of that recitation, one of ordinary skill in the art would have envisaged the simplest of clamps, i.e., the simple piece of material the same width as the band folded over the ends of the band as shown in Perthou's figures.

Moreover, during patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the Specification, as the claim language would have been read by one of ordinary skill in the art in view of the Specification, *see Zletz*, 893 F.2d at 321, 13 USPQ2d 1320; *Sneed*, 710 F.2d at 1548, and the clamp shown in the Appellant's figures 1-5 is the same as that shown in Perthou's figures 1-5. Hence, the Appellant's term "clamp", when most broadly construed by one of ordinary skill in the art in view of the Appellant's Specification, would have included Perthou's clamp.

Therefore, Perthou's claimed design would have been *prima facie* obvious to one of ordinary skill in the art in view of the Appellant's claim 3.

Conversely, as indicated above, Perthou's claimed design, as shown in the figures, includes a component falling within each limitation recited in the Appellant's claim 3. The invention claimed in the Appellant's claim 3, therefore, at least would have been *prima facie* obvious to one of ordinary skill in the art over Perthou's claim.

The Appellants claim 5, which depends from claim 3, recites that the clamp width is substantially the same as the width of the band. Thus, claim 5 recites, regarding

the relative widths of the clamp and the band, what one of ordinary skill in the art would have envisaged, as pointed out above, given the recitation in claim 3.

Therefore, for the reasons given above regarding claim 3, the invention claimed in the Appellant's claim 5 would have been prima facie obvious to one of ordinary skill in the art over Perthou's claim, and vice versa.

Because, as discussed above, the inventions claimed in the Appellants claims 3 and 5 would have been prima facie obvious to one of ordinary skill in the art over Perthou's claim and vice versa, the inventions claimed in the Appellant's claims 3 and 5 would have been prima facie obvious to one of ordinary skill in the art under the doctrine of obviousness-type double patenting.

The Appellant argues that "[a] device could be constructed that would infringe the claims of the utility patent [application] but not the very narrow claim of the design patent" (Br. 4).

The Appellant's claims 3 and 5 encompass structures other than that in Perthou's claim. However, Perthou's claimed design is the simplest, most utilitarian of designs, i.e., a simple D-ring having the bar and U-shape recited in the Appellant's claim 1, the simplest of bands (a plain rectangular band) engaged with the D-ring in the simplest of ways, i.e., looped over the D-ring's bar, a simple spiral round wire key-holding ring engaged with the D-ring in the simplest of ways, i.e., looping engagement, and the simplest of ways for attaching together the sides of the loops, i.e., a simple clamp comprising a piece of material the same width as the band folded over the end of the band. Because Perthou's design is the simplest, most utilitarian of designs, that design would have been envisaged by one of ordinary skill in the art given the recitations in Appellant's claims 3 and 5.

Also, as pointed out above, because the Appellant's claim terms are construed in view of the Appellant's Specification, the drawings of which show Perthou's design, one of ordinary skill in the art would have construed the Appellant's claim 3 and 5 as including Perthou's design. Pp. 2-7.

Claim 3 is dependent upon and includes all the limitations of claim 1 and rewritten in independent form reads as follows.

A key ring comprising
A key-holding ring having a cross sectional span
a band,
a D-ring coupling said band to said key-holding ring,
said D-ring having a U-shaped portion engaging the key-holding ring and a bar
having bar ends between the U ends of the U-shaped portion of length
corresponding to the distance between the U ends and engaging the band over
substantially the entire length of the bar formed with a gap intermediate the U

ends of gap width about that of said cross-sectional span to allow said key-holding ring to pass through said gap into said D-ring during assembly, and further comprising a clamp at the band ends of said web of material.

Claim 5 is also dependent upon and includes all the limitations of claim 1 and rewritten in independent form reads as follows.

A key ring comprising
A key-holding ring having a cross sectional span
a band,
a D-ring coupling said band to said key-holding ring, said D-ring having a U-shaped portion engaging the key-holding ring and a bar having bar ends between the U ends of the U-shaped portion of length corresponding to the distance between the U ends and engaging the band over substantially the entire length of the bar formed with a gap intermediate the U ends of gap width about that of said cross-sectional span to allow said key-holding ring to pass through said gap into said D-ring during assembly, wherein the clamp width is substantially the same as the width of the band.

In its decision, the Board said:

Perthou's claim, however, as shown in the figures, requires what appears to be a clamp at the end of the band opposite the D-ring. The Appellant's Specification indicates that what appears to be a clamp in Perthou's figures is a clamp (Spec. 3:5-9), but the clamp is not recited in claim 1, its dependent claims 2, 4, 6, 7 and 9, or independent method claim 11. thus, the Examiner has not established that the recitations in those claims are sufficient to have rendered Perthou's design patent claim prima facie obvious to one of ordinary skill in the art.

Also, the Appellant's claims 6-11 require a gap in the D-ring's bar. That gap is not shown in Perthou's figures. The Examiner has not explained, and it is not apparent how Perthou's claim which lacks the appearance of a gap would have rendered the gap required by the Appellant's claims 6-11 prima facie obvious to one of ordinary skill in the art. P. 5.

Both claims 3 and 5 now include at least the gap in the D-ring's bar. The law of the case therefore is that there is no obvious-type double patenting of claims reciting the gap in the D-ring.

II. WHETHER CLAIMS 1, 6 AND 11 ARE UNPATENTABLE UNDER 35 U.S.C. §103(a) OVER CHEN AS A PRIMARY REFERENCE IN VIEW OF JUNG AS A SECONDARY REFERENCE AND MOMEMERS AS A TERTIARY REFERENCE.

The final action states:

4. Claims 1,6,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen 5,069,050 in view of Jung 4,903,514, and Momemers 4,523,443.

5. Chen discloses a separable key holder comprising a pair of elongated, preferably flexible and rectangular straps (16, 18), most of one surface of each strap having thereon a patch of hook and loop fastening material (20 or 22) for releasable attachment to the comparable hook and loop fastening material of the other strap (col. 3, 11. 19-25, 35-39). An end of each strap is free of hook and loop fastening material, passes through a circular key holding element (12 or 14), and is folded back upon itself and sealed to itself, preferably by heat sealing, so as to hold the key holding element in looping engagement with the strap (col. 3, 11.41-54; figs. 1, 2).

Jung discloses a combined nail clipper and key holder comprising an elongated nail clipper container (11), a triangular-shaped connecting member (14), one side of which has a gap in its central portion with a prong on each side of the gap that extends into nail clipper container 11 for fastening connecting member 14 to nail clipper container 11, and a key ring (15) in looping engagement with connecting member 14 (col. 2, 11. 18-22, 45-50; figs. 1, 3).

Momemers discloses a key keeper comprising a D-shaped loop (3) having a U-shaped portion and, between the ends of the U-shaped portion, a bar having a gap (17) therein for receipt of keys onto loop 3 (abstract; col. 2, 11. 39-41; fig. 1). On each side of the gap is a leg (15 or 16) that projects into a cavity in a loop holder (2) (col. 3, 11. 44-47; fig. 1).

The Appellant questions the desirability of combining the references to arrive at the claimed invention (Br. 4-7; Reply Br. 2-3).

As stated by the Supreme Court in *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent

reason to combine the known elements in the fashion claimed by the patent at issue.

Chen's key holding elements 12 and 14 are attached directly to straps 16 and 18 without an intervening ring (figs. 1, 2). However, Jung's disclosure of connecting member 14 (col. 2, 11. 45-47) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use an intervening ring in Chen's key holder to provide the readily apparent benefits of rendering the key holding element attachment releasable and permitting multiple key holding elements to be attached to each strap. See *KSR*, 127 S.Ct. at 1741 (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ").

Jung's connecting member 14 is not D-shaped. However, Jung does not set forth any significance of the shape of connecting member 14, other than indicating that it must have a bar comprising inwardly extending prongs with a gap there between for attaching connecting member 14 to clipper container 11 (figs. 1, 3). Hence, one of ordinary skill in the art would have been led, through no more than ordinary creativity, to use other shapes that provide inwardly extending prongs, such as Momemers's D-shaped loop loop 3 (fig. 1).

Although Momemers's loop 3 is a key-retaining loop rather than a connecting member (abstract), one of ordinary skill in the art would have appreciated that the gap in Momemers's loop that is suitable for receiving keys (col. 3, 1.42) also would be suitable for receiving a key ring. As stated by the Supreme Court in *KSR*, 127 S.Ct. at 1740, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."

Regarding claim 11, Chen's key-holding elements 12 and 14 are attached to straps 16 and 18 preferably by heat sealing, and alternatively by stitching (col. 3, 11. 50-53), not by passing the ends of straps 16 and 18 through a gap in key-holding elements 12 and 14. However, one of ordinary skill in the art would have been led, through no more than ordinary creativity, by Momemers's disclosures that key retaining loop 3 has a bar with a gap (abstract; fig. 1) and that keys can be inserted through the gap (abstract; col. 3, 1. 42; fig. 1), to attach Chen's straps 16 and 18 through a gap so that straps 16 and 18 can be releasably attached to the D-ring of the combined disclosures of Chen, Jung and Momemers, and so that the loops at the ends of the straps can be formed in advance by heat sealing or stitching and later attached to key-holding elements 12 and 14. Pp. 8-11

This ground of rejection is respectfully traversed.

The Board quoted a portion of a paragraph in *KSR Int'l Co. v. Teleflex Inc.*, 127S. Ct. 1727, 1740-41 (2007). The following sentence reads "See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]jections on obvious grounds cannot be sustained by mere conclusory statements, instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

In *Ex parte Aylward*, (BPA&I, Appeal No. 2007-2368 December 4, 2007) the Board said in reversing a final rejection,

"Both anticipation under §102 and obviousness under §103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . The second step in the analysis requires a comparison of the properly constructed claims to the prior art". *Medichem, S.A. v. Rolabo, SL.*, 353 F. 3d 928, 933 (Fed. Cir. 2003) (internal citations omitted):

A. CLAIM CONSTRUCTION

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry* 32 F. 3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F. 2d. 1381, 1385 (Fed. Cir. 1983). Slip Op. Pp. 7-8.

* * *

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *in re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781,783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F. 2d 1048, 1051 (CCPA 1976)). P. 9.

In *Ex parte Hamilton* (BPA&I Appeal No. 2007-3091, March 11, 2008) in reversing a final rejection the Board said:

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991), and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Slip Op. Pp. 5-6.

As noted above the PTO must first consider all claim limitations when determining patentability of the invention over the prior art. Claim 1 as amended recites the D-ring coupling the band to the key holding ring having a U-shaped portion engaging the key-holding ring and a bar having bar ends between the U-ends of the U-shaped portion of length corresponding to the distance between the U ends and engaging the band over substantially the entire length of the bar formed with a gap intermediate the U ends of gap width about that of the cross-sectional span of the key-holding ring to allow the key-holding ring to pass through the gap into the D-ring during assembly. The Chen primary reference does not disclose a D-ring coupling a key-holding ring to a band but only discloses the key-holding ring directly connected to the band. The Jung secondary reference does not disclose a D-ring coupling the key-holding ring to the nail clipper container but only discloses a triangular member that is not a D-ring coupling the key ring to the clipper container that has its two legs bent at each end to form prongs that engage a hole in the clipper container 11 and are separated by a distance much greater than the cross-sectional span of key ring 15.

The Momemers tertiary reference does not overcome the deficiencies of the primary or secondary references. Key retaining loop 3 is not a D-ring. Opening 17 has a gap width that bears no relationship to the cross-sectional span of a key ring, the only key ring disclosed in the tertiary reference being loop 3 having a cross-sectional span several times that of gap 17.

It is clear from the specification and drawing that the D-ring has the shape of the letter D formed by a U portion having ends joined by a bar.

It is thus apparent that it is impossible to combine the primary, secondary and tertiary references to form the invention of claims 1, 6 and 11 as amended.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to

agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the primary, secondary and tertiary references to meet the limitations of amended claims 1, 6 and 11 is reason enough for reversing the rejection of them.

It is impossible for the Examiner to satisfy her burden by showing articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, for combining teachings of the primary, secondary and tertiary references would not have suggested to one of ordinary skill in the art to make the invention defined by the active claims as amended.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.¹⁵ This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹⁶ *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

The Examiner was respectfully requested to quote verbatim the language in the references corresponding to each limitation in a rejected claim, and the language in the references regarded as motivating a person of ordinary skill in the key holder art to combine what is disclosed in the references to meet the limitations of the rejected claims. The Examiner did not and cannot comply with this request.

To this end, apart from not providing any motivation to a person of ordinary skill in the art to combine what is disclosed in the three references to meet the limitations of the rejected

claims, the inventors in the three patents are inventors of extraordinary skill in the art, and nothing in the disclosures by these inventors of extraordinary skill remotely motivate a person of ordinary skill in the key holder art to combine what is there disclosed to meet the limitations of the rejected claims.

III. WHETHER CLAIMS 2 AND 4 ARE UNPATENTABLE UNDER SECTION 35 U.S.C. §103(a) OVER CHEN AS A PRIMARY REFERENCE IN VIEW OF JUNG AS A SECONDARY REFERENCE, MOMEMERS AS A TERTIARY REFERENCE AND MILLER AS A QUATERNARY REFERENCE.

The final action states:

6. Claims 2,4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Jung and Momemers, as applied to claim 1 above, and further in view of Miller 1,704,137.

7. Miller discloses a key holder comprising a strip of material, preferably leather, that is folded over at an end to form a loop through which a key chain passes, is closed by stitching (16) at the other end, and has one snap fastener (28) at each of its side edges intermediate the fold and stitching 16 to fasten together the side edges (p. 1, 11. 32-57; fig. 3).

The Appellant argues that the applied references do not suggest the desirability of the limitations in the Appellant's claims 2, 4, 7 and 9 (Br. 9).

Regarding claim 2, Chen discloses a web (straps 16, 18) looped through key-holding elements 12 and 14 (col. 3, 11. 19-25; figs. 1, 2). Attaching a D-ring to straps 16 and 18 would have been obvious to one of ordinary skill in the art for the reasons given above regarding the rejection of claims 1, 6 and 11. Like the Appellant's D-ring, that D-ring would have the ability to rotate through an angle of nearly 360 degrees and would permit rotation of a key-holding ring looped with it to ride along the inside of its U-shaped inside portion for substantially 180 degrees as required by the Appellant's claim 4.

With respect to the requirement of claims 7 and 9 that the key-holding ring is a spiral ring, Chen discloses in figure 4 what appears to be a conventional spiral key ring (12). Also, Jung discloses what appears to be a conventional spiral key ring (15) (fig. 1), and Chen's disclosure of a key holding ring (col. 3, 11. 19-20; figs. 1, 2) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use as the ring any known key holding ring such as the apparently-conventional spiral ring disclosed by Jung. Pp. 11-12.

Since claims 2 and 4 are dependent upon and include all the limitations of amended claim 1, the reasoning set forth above in support of the patentability of claim 1 over the primary, secondary and tertiary references is submitted to support the patentability of claims 2 and 4 adding Miller as a quaternary reference. Accordingly, claims 2 and 4 meet the conditions for patentability. If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in the references regarded as corresponding to each limitation in claims 2 and 4. The Examiner did not and can not comply with this request.

CONCLUSION

In view of the foregoing authorities, reasoning and the inability of multiplicity of prior art references to make obvious the subject matter as a whole of the claimed invention, the decision of the Examiner finally rejecting all the active claims should be reversed. If the Board believes a claim may be allowed in amended form, the Board is respectfully requested to include an explicit statement that such a claim may be allowed in such amended form and direct that Appellant shall have the right to amend in conformity with such statement in the absence of new references or grounds of rejection.

The brief fee was enclosed with the first appeal brief and is not believed to be required for the third appeal brief. Please apply any other charges or credits to Deposit Account No. 06-1050, Order No. 08914-0009001.

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Respectfully submitted,
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(viii) *Claims Appendix*

1. A key ring comprising
 A key-holding ring having a cross sectional span
 a band,
 a D-ring coupling said band to said key-holding ring,
said D-ring having a U-shaped portion engaging the key-holding ring and a bar having bar ends between the U ends of the U-shaped portion of length corresponding to the distance between the U ends and engaging the band over substantially the entire length of the bar formed with a gap intermediate the U ends of gap width about that of said cross-sectional span to allow said key-holding ring to pass through said gap into said D-ring during assembly.
2. A key ring in accordance with claim 1 wherein the band is a web of material having band ends looped through the D-ring and joined at said band ends.
3. A key ring in accordance with claim 2 and further comprising a clamp at the band ends of said web of material.
4. A key ring in accordance with claim 2 wherein the web has portions that are fastened together for most of their length to define an opening accommodating the bar of the D-ring so that the D-ring may rotate about the axis of the bar through an angle of nearly 360 degrees and the key-holding ring may ride along the inside portion of the U-shaped portion of the D-ring about an axis perpendicular to the axis of the bar and perpendicular to the band for substantially 180 degrees.
5. A key ring in accordance with claim 3 wherein the clamp width is substantially the same as the width of the band.
6. A key ring in accordance with claim 1 where said key-holding ring is a spiral ring.

11. A method of making a key ring that includes a key-holding ring having a cross-sectional span, a band, a D-ring coupling said band to said key-holding ring and having a U-shaped portion engaging the key-holding ring and a bar having bar ends between the U ends of the U-shaped portion of length corresponding to the distance between the U ends formed with a gap intermediate said bar ends of gap width about that of said cross-sectioned span to allow said key-holding ring to pass through said gap into said D-ring during assembly, comprising,

- passing the key-holding ring through the gap into the D-ring,
- passing the band through the D-ring about the bar so that opposed portions of the band may be fastened together for most of the length of the band,
- and fastening the opposed portions together.

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(ix) *Evidence Appendix*

NONE.

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(x) Related Proceedings Appendix

Please see Decision on Appeal dated May 7, 2008, attached.



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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER PERTHOU

Appeal No. 2007-2838
Application No. 09/752,015
Technology Center 3600

Decided: May 7, 2008

Before TERRY J. OWENS, HUBERT C. LORIN and JOHN C. KERINS,
Administrative Patent Judges.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

The Appellant appeals from a rejection of claims 1-11, which are all of the pending claims.

THE INVENTION

The Appellant claims a key ring and a method for making it. Claims 1 and 11 are illustrative:

1. A key ring comprising,
a key-holding ring,

a band,

a D-ring coupling said band to said key-holding ring,

said D-ring having a U-shaped portion engaging the key-holding ring and a bar between the ends of the U-shaped portion and engaging the band.

11. A method of making a key ring that includes a key-holding ring that is a spiral ring of material having a cross-sectional span, a band, a D-ring coupling said band to said key-holding ring and having a U-shaped portion engaging the key-holding ring and a bar having bar ends between the ends of the U-shaped portion formed with a gap intermediate said bar ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly, comprising,

passing the key-holding ring through the gap into the D-ring, and

passing the band through the D-ring.

THE REFERENCES

Miller	US 1,704,137	Mar. 5, 1929
Momemers	US 4,523,443	Jun. 18, 1985
Sheldon	US 4,601,185	Jul. 22, 1986
Jung	US 4,903,514	Feb. 27, 1990
Chen	US 5,069,050	Dec. 3, 1991
Perthou	US D435,720 S	Jan. 2, 2001

THE REJECTIONS

The claims stand rejected as follows: claims 1-11 under the judicially created doctrine of obviousness-type double patenting over the claim of Perthou; claims 1, 6 and 11 under 35 U.S.C. § 103 over Chen in view of Jung and either Momemers or Sheldon; and claims 2-5 and 7-10 under 35 U.S.C. § 103 over Chen in view of Jung, either Momemers or Sheldon, and Miller.

OPINION

The obviousness-type double patenting rejection is reversed as to claims 1, 2, 4 and 6-11, and affirmed as to claims 3 and 5. The rejection under 35 U.S.C. § 103 over Chen in view of Jung and Momemers is affirmed. The rejection under 35 U.S.C. § 103 over Chen in view of Jung, Momemers and Miller is affirmed as to claims 2, 4, 7 and 9, and reversed as to claims 3, 5, 8 and 10. The rejections under 35 U.S.C. § 103 over Chen in view of Jung and Sheldon and over Chen in view of Jung, Sheldon and Miller are reversed. Because the affirmances are based upon reasoning that differs substantially from that set forth by the Examiner, we denominate the affirmances as involving new grounds of rejection.

Obviousness-type double patenting rejection

Claims 1, 2, 4 and 6-11

An “obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that ‘the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa’”. *In re Dembiczak*, 175 F.3d 994, 1002 (Fed. Cir. 1999), quoting *Carmen Indus., Inc. v. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983). “In order for a design to be unpatentable because of obviousness, there must first be a basic design reference in the prior art, the design characteristics of which are ‘basically the same as the claimed design’”. *Dembiczak* at 1002, quoting *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996). Thus, for a utility patent application claim to render obvious a design patent claim, the utility patent application claim must indicate design

characteristics that are basically the same as the claimed design. *See Dembiczak* at 1002.

The Appellant's claim 1, which is the sole independent claim among claims 1, 2, 4 and 6-10, recites "a key-holding ring". In view of that recitation, one of ordinary skill in the art would have envisaged the most basic of key-holding rings, i.e., the simple spiral round wire key-holding ring shown in Perthou's figures that has been ubiquitous for generations.

The Appellant's claim 1 recites "a band". In view of that recitation, one of ordinary skill in the art would have envisaged the simplest of bands, i.e., the simple, plain, rectangular band shown in Perthou's figures.

The Appellant's claim 1 recites "a D-ring coupling said band to said key-holding ring, said D-ring having a U-shaped portion engaging the key-holding ring and a bar between the ends of the U-shaped portion and engaging the band". That description describes the D-ring in Perthou's figures. In view of that recitation, the engagement between the D-ring and the key-holding ring that would have been envisaged by one of ordinary skill in the art would have been the conventional engagement, i.e., each ring passing through the opening in the other ring as shown in Perthou's figures. In view of that recitation, one of ordinary skill in the art would have envisaged the simplest engagement between the bar and the band, i.e., the band looped around a bar of the same width as the band as shown in Perthou's figures.

Moreover, during patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the Specification, as the claim language would have been read by one of ordinary skill in the art in view of the Specification, *see In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). Therefore, the Appellant's terms "key-holding

ring”, “band” and “D-ring” would have been construed by one of ordinary skill in the art as including those in the Appellant’s figures 1-5, which are the same as those required by Perthou’s claim.

Perthou’s claim, however, as shown in the figures, requires what appears to be a clamp at the end of the band opposite the D-ring. The Appellant’s Specification indicates that what appears to be a clamp in Perthou’s figures is a clamp (Spec. 3:5-9),¹ but the clamp is not recited in claim 1, its dependent claims 2, 4, 6, 7 and 9, or independent method claim 11. Thus, the Examiner has not established that the recitations in those claims are sufficient to have rendered Perthou’s design patent claim *prima facie* obvious to one of ordinary skill in the art.

Also, the Appellant’s claims 6-11 require a gap in the D-ring’s bar. That gap is not shown in Perthou’s figures. The Examiner has not explained, and it is not apparent, how Perthou’s claim which lacks the appearance of a gap would have rendered the gap required by the Appellant’s claims 6-11 *prima facie* obvious to one of one of ordinary skill in the art.

Claims 3 and 5

Claim 2, from which claim 3 depends, recites that the band is a web of material having ends looped through the D-ring and joined at the ends. That recitation describes the band and looping engagement between the band and the D-ring shown in Perthou’s figures. Claim 3 recites that there is a clamp at the ends of the web. In view of that recitation, one of ordinary skill in the art would have envisaged the simplest of clamps, i.e., the simple piece of material the same width

¹ The Appellant’s Specification states: “Referring to FIG. 6, there is shown a plan view of another embodiment with clamp 14’ extending slightly beyond the width

as the band folded over the ends of the band as shown in Perthou's figures. Moreover, during patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the Specification, as the claim language would have been read by one of ordinary skill in the art in view of the Specification, *see Zletz*, 893 F.2d at 321, 13 USPQ2d 1320; *Sneed*, 710 F.2d at 1548, and the clamp shown in the Appellant's figures 1-5 is the same as that shown in Perthou's figures 1-5. Hence, the Appellant's term "clamp", when most broadly construed by one of ordinary skill in the art in view of the Appellant's Specification, would have included Perthou's clamp.

Therefore, Perthou's claimed design would have been *prima facie* obvious to one of ordinary skill in the art in view of the Appellant's claim 3.

Conversely, as indicated above, Perthou's claimed design, as shown in the figures, includes a component falling within each limitation recited in the Appellant's claim 3. The invention claimed in the Appellant's claim 3, therefore, at least would have been *prima facie* obvious to one of ordinary skill in the art over Perthou's claim.

The Appellant's claim 5, which depends from claim 3, recites that the clamp width is substantially the same as the width of the band. Thus, claim 5 recites, regarding the relative widths of the clamp and the band, what one of ordinary skill in the art would have envisaged, as pointed out above, given the recitation in claim 3. Therefore, for the reasons given above regarding claim 3, the invention claimed in the Appellant's claim 5 would have been *prima facie* obvious to one of ordinary skill in the art over Perthou's claim, and vice versa.

of band 13 and having rounded corners" (Spec. 3:5-9) However, there appears to be no figure 6 of record.

Because, as discussed above, the inventions claimed in the Appellant's claims 3 and 5 would have been prima facie obvious to one of ordinary skill in the art over Perthou's claim and vice versa, the inventions claimed in the Appellant's claims 3 and 5 would have been prima facie obvious to one of ordinary skill in the art under the doctrine of obviousness-type double patenting.

The Appellant argues that "[a] device could be constructed that would infringe the claims of the utility patent [application] but not the very narrow claim of the design patent" (Br. 4).

The Appellant's claims 3 and 5 encompass structures other than that in Perthou's claim. However, Perthou's claimed design is the simplest, most utilitarian of designs, i.e., a simple D-ring having the bar and U-shape recited in the Appellant's claim 1, the simplest of bands (a plain rectangular band) engaged with the D-ring in the simplest of ways, i.e., looped over the D-ring's bar, a simple spiral round wire key-holding ring engaged with the D-ring in the simplest of ways, i.e., looping engagement, and the simplest of ways for attaching together the sides of the loops, i.e., a simple clamp comprising a piece of material the same width as the band folded over the end of the band. Because Perthou's design is the simplest, most utilitarian of designs, that design would have been envisaged by one of ordinary skill in the art given the recitations in Appellant's claims 3 and 5. Also, as pointed out above, because the Appellant's claim terms are construed in view of the Appellant's Specification, the drawings of which show Perthou's design, one of ordinary skill in the art would have construed the Appellant's claim 3 and 5 as including Perthou's design.

Accordingly, we affirm the rejection of claims 3 and 5 under the judicially created doctrine of obviousness-type double patenting over Perthou's claim. Because the affirmance is based upon substantially different reasoning than that

advanced by the Examiner, we denominate the affirmance as involving a new ground of rejection.

Rejection of claims 1, 6 and 11 under 35 U.S.C. § 103
over Chen in view of Jung and Momemers

Chen discloses a separable key holder comprising a pair of elongated, preferably flexible and rectangular straps (16, 18), most of one surface of each strap having thereon a patch of hook and loop fastening material (20 or 22) for releasable attachment to the comparable hook and loop fastening material of the other strap (col. 3, ll. 19-25, 35-39). An end of each strap is free of hook and loop fastening material, passes through a circular key holding element (12 or 14), and is folded back upon itself and sealed to itself, preferably by heat sealing, so as to hold the key holding element in looping engagement with the strap (col. 3, ll. 41-54; figs. 1, 2).

Jung discloses a combined nail clipper and key holder comprising an elongated nail clipper container (11), a triangular-shaped connecting member (14), one side of which has a gap in its central portion with a prong on each side of the gap that extends into nail clipper container 11 for fastening connecting member 14 to nail clipper container 11, and a key ring (15) in looping engagement with connecting member 14 (col. 2, ll. 18-22, 45-50; figs. 1, 3).

Momemers discloses a key keeper comprising a D-shaped loop (3) having a U-shaped portion and, between the ends of the U-shaped portion, a bar having a gap (17) therein for receipt of keys onto loop 3 (abstract; col. 2, ll. 39-41; fig. 1). On each side of the gap is a leg (15 or 16) that projects into a cavity in a loop holder (2) (col. 3, ll. 44-47; fig. 1).

The Appellant questions the desirability of combining the references to arrive at the claimed invention (Br. 4-7; Reply Br. 2-3).

As stated by the Supreme Court in *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Chen's key holding elements 12 and 14 are attached directly to straps 16 and 18 without an intervening ring (figs. 1, 2). However, Jung's disclosure of connecting member 14 (col. 2, ll. 45-47) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use an intervening ring in Chen's key holder to provide the readily apparent benefits of rendering the key holding element attachment releasable and permitting multiple key holding elements to be attached to each strap. *See KSR*, 127 S.Ct. at 1741 (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ").

Jung's connecting member 14 is not D-shaped. However, Jung does not set forth any significance of the shape of connecting member 14, other than indicating that it must have a bar comprising inwardly extending prongs with a gap therebetween for attaching connecting member 14 to clipper container 11 (figs. 1, 3). Hence, one of ordinary skill in the art would have been led, through no more than ordinary creativity, to use other shapes that provide inwardly extending prongs, such as Momemers's D-shaped loop 3 (fig. 1).

Although Momemers's loop 3 is a key-retaining loop rather than a connecting member (abstract), one of ordinary skill in the art would have appreciated that the gap in Momemers's loop that is suitable for receiving keys (col. 3, l. 42) also would be suitable for receiving a key ring. As stated by the Supreme Court in *KSR*, 127 S.Ct. at 1740, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."

Regarding claim 11, Chen's key-holding elements 12 and 14 are attached to straps 16 and 18 preferably by heat sealing, and alternatively by stitching (col. 3, ll. 50-53), not by passing the ends of straps 16 and 18 through a gap in key-holding elements 12 and 14. However, one of ordinary skill in the art would have been led, through no more than ordinary creativity, by Momemers's disclosures that key-retaining loop 3 has a bar with a gap (abstract; fig. 1) and that keys can be inserted through the gap (abstract; col. 3, l. 42; fig.1), to attach Chen's straps 16 and 18 through a gap so that straps 16 and 18 can be releasably attached to the D-ring of the combined disclosures of Chen, Jung and Momemers, and so that the loops at the ends of the straps can be formed in advance by heat sealing or stitching and later attached to key-holding elements 12 and 14.

For the above reasons we are not convinced of reversible error in the rejection of claims 1, 6 and 11 under 35 U.S.C. § 103 over Chen in view of Jung and Momemers. Accordingly, we affirm that rejection. Because our reasoning differs significantly from the Examiner's reasoning, we denominate the affirmance as involving a new ground of rejection.

Rejection of claims 1, 6 and 11 under 35 U.S.C. § 103
over Chen in view of Jung and Sheldon

Sheldon discloses a key locator (10) comprising a flexible, rectangular tab (12) (col. 2, ll. 8-11). At one end of tab 12 is a folded portion (19) that is folded around a key (11) and has a hole therethrough on each side of a hole in key 11 (col. 2, ll. 20-23). A spring clip (20) having a hole therethrough holds key 11 in place, and a circular key ring (21) passes through the holes in spring clip 20, folded portion 19 and key 11 (col. 2, ll. 49-63; figs. 1, 2). At the other end of tab 12 is a fold (15) which attaches to tab 12 a ring (18) having a unique shape that provides a tactile clue for selecting the desired tab and key from among other tabs and keys on key ring 21 (col. 3, ll. 6-15).

The Examiner argues that “Sheldon teaches both ‘V’ and ‘U’-shaped rings in Figure 2” (Ans. 4).

Those rings (18, 18A) are at the end of tabs 12 opposite the key and are used for providing a tactile clue for identifying the keys rather than for attaching them to key ring 21 (col. 3, ll. 6-18). The Examiner has not established that the applied prior art would have led one of ordinary skill in the art to use those rings to attach keys to a key ring.

Accordingly, we reverse the rejection of claims 1, 6 and 11 under 35 U.S.C. § 103 over Chen in view of Jung and Sheldon.

Rejection of claims 2, 4, 7 and 9 under 35 U.S.C. § 103
over Chen in view of Jung, Momemers and Miller

Miller discloses a key holder comprising a strip of material, preferably leather, that is folded over at an end to form a loop through which a key chain passes, is closed by stitching (16) at the other end, and has one snap fastener (28) at each of its side edges intermediate the fold and stitching 16 to fasten together the side edges (p. 1, ll. 32-57; fig. 3).

The Appellant argues that the applied references do not suggest the desirability of the limitations in the Appellant's claims 2, 4, 7 and 9 (Br. 9).

Regarding claim 2, Chen discloses a web (straps 16, 18) looped through key-holding elements 12 and 14 (col. 3, ll. 19-25; figs. 1, 2). Attaching a D-ring to straps 16 and 18 would have been obvious to one of ordinary skill in the art for the reasons given above regarding the rejection of claims 1, 6 and 11. Like the Appellant's D-ring, that D-ring would have the ability to rotate through an angle of nearly 360 degrees and would permit rotation of a key-holding ring looped with it to ride along the inside of its U-shaped inside portion for substantially 180 degrees as required by the Appellant's claim 4.

With respect to the requirement of claims 7 and 9 that the key-holding ring is a spiral ring, Chen discloses in figure 4 what appears to be a conventional spiral key ring (12). Also, Jung discloses what appears to be a conventional spiral key ring (15) (fig. 1), and Chen's disclosure of a key holding ring (col. 3, ll. 19-20; figs. 1, 2) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use as the ring any known key holding ring such as the apparently-conventional spiral ring disclosed by Jung.

For the above reasons we are not persuaded of reversible error in the rejection of claims 2, 4, 7, and 9 under 35 U.S.C. § 103 over Chen in view of Jung, Momemers and Miller. We therefore affirm that rejection. Because our reasoning differs substantially from that of the Examiner, we denominate the affirmance as involving a new ground of rejection.

Rejection of claims 3, 5, 8 and 10 under 35 U.S.C. § 103
over Chen in view of Jung, Momemers and Miller

The Appellant's claim 3 and claims 5, 8 and 10 that depend directly or indirectly therefrom require a clamp at the ends of the web of material.

The Examiner considers Miller's stitches 16 to be a "stitch clamp means" (Ans. 5).

During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the Specification, as the claim language would have been read by one of ordinary skill in the art in view of the Specification. *See Zletz*, 893 F.2d at 321; *Sneed*, 710 F.2d at 1548. The only clamp disclosed by the Appellant is a piece of material (14) that is folded over and pressed against the web to hold the ends of the web together (Spec. 3:5-6; figs. 1-5). That disclosure is consistent with the dictionary definition of "clamp", which is:

1: a device designed to bind or constrict or to press two or more parts together so as to hold them firmly 2: any of various instruments or appliances having parts brought together for holding or compressing something^[2][.]

The Examiner has not established that Miller's stitches 16 reasonably can be considered a device or an instrument.

The Examiner, therefore, has not established a prima facie case of obviousness under 35 U.S.C. § 103 of the inventions claimed in the Appellant's claims 3, 5, 8 and 10.

Rejection of claims 2-5 and 7-10 under 35 U.S.C. § 103
over Chen in view of Jung, Sheldon and Miller

The Examiner does not rely upon Miller for any disclosure that remedies the deficiency in Chen, Jung and Sheldon as to claim 1 from which claims 2-5 and 7-10 directly or indirectly depend (Ans. 4-5). Also, regarding claims 3, 5, 8 and 10,

² *Webster's New Collegiate Dictionary* 205 (G. & C. Merriam 1973).

as discussed above with respect to the rejection over Chen in view of Jung, Momemers and Miller, the Examiner has not established that Miller discloses a clamp, as that term would have been most broadly construed in view of the Appellant's Specification.

Hence, the Examiner has not established a prima facie case of obviousness of the inventions claimed in the Appellant's claims 2-5 and 7-10 under 35 U.S.C. § 103 over Chen in view of Jung, Sheldon and Miller.

DECISION

The rejection of claims 1-11 under the judicially created doctrine of obviousness-type double patenting over the claim of Perthou is reversed as to claims 1, 2, 4 and 6-11, and affirmed as to claims 3 and 5. The rejection of claims 1, 6 and 11 under 35 U.S.C. § 103 over Chen in view of Jung and Momemers is affirmed. The rejection of claims 1, 6 and 11 under 35 U.S.C. § 103 over Chen in view of Jung and Sheldon is reversed. The rejection of and claims 2-5 and 7-10 under 35 U.S.C. § 103 over Chen in view of Jung, Momemers and Miller is affirmed as to claims 2, 4, 7 and 9, and reversed as to claims 3, 5, 8 and 10. The rejection of claims 2-5 and 7-10 under 35 U.S.C. § 103 over Chen in view of Jung, Sheldon and Miller is reversed. Because the affirmances are based upon reasoning which differs substantially from that advanced by the Examiner, we denominate the affirmances as involving new grounds of rejection.

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides

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"[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

AFFIRMED-IN-PART, 37 C.F.R. § 41.50(b)

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